

Attorney Docket No. 1614.1208

S&H Form (2/01)

DEP-5 REF

ACCOUNTING

2008 MAY 23 AM 3:19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kazutomi TANEDA, et al.

Application No.: 10/046,498

Group Art Unit: 3693

Confirmation No.: 1961

Filed: January 16, 2002

Examiner: BARTLEY, KENNETH

For: ELECTRONIC COMMERCIAL TRANSACTION METHOD AND APPARATUS FOR COMMUNICATING, VIA A NETWORK, VIRTUAL PERSONAL INFORMATION HAVING A REPRESENTATION FORMAT SIMILAR TO THAT OF REAL PERSONAL INFORMATION AND A CONVERTER CONVERTING THE VIRTUAL, INTO THE REAL, PERSONAL INFORMATION BASED ON REGISTERED INFORMATION

REQUEST FOR REFUND TO DEPOSIT ACCOUNT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:


The Monthly Statement of Deposit Account (dated May 21, 2008) is showing a charge of \$210.00 related to the above-referenced application. The charge is marked with Fee Code 1201, which relates to the Patent Office Fees for filing an extra independent claim. This application has five (5) independent claims, which have been previously paid for. The fifth independent claim was previously paid for on December 10, 2007 at the time of filing the Request for Continued Examination and the Amendment. Further, no such extra independent claim was ever requested by the undersigned in the Amendment filed on April 25, 2008. Therefore, the charge for the extra independent claim on May 21, 2008 was unnecessary.

Accordingly, it is respectfully requested that this charge in the amount of \$210.00 be credited to Deposit Account No. 19-3935 and that the Patent Office acknowledge this credit in writing to the undersigned.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 5/22/08

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S&H Form: (09/07)

**REPLY/AMENDMENT
FEE TRANSMITTAL**

Attorney Docket No.	1614.1208
Application Number	10/046,498
Filing Date	January 16, 2002
First Named Inventor	Kazutomi TANEDA, et al.
Group Art Unit	3693
Examiner Name	BARTLEY, KENNETH

AMOUNT ENCLOSED

0.00

FEE CALCULATION (fees effective 09/30/07)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	16	- 20 =	0	X \$ 50.00 =	\$ 0.00
INDEPENDENT CLAIMS	15	- 20 =	0	X \$ 210.00 =	0.00

Since an Official Action set an original due date of April 25, 2008, petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$120)); (2 months (\$460)); (3 months (\$1,050)); (4 months (\$1,640)); (5 months (\$2,230):

If Notice of Appeal is enclosed, add (\$510.00)

If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$130.00)

Information Disclosure Statement (Rule 1.17(p)) (\$180.00)

Total of above Calculations =

\$ 0.00

Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)

TOTAL FEES DUE =

\$ 0.00

- (1) If entry (1) is less than entry (2), entry (3) is "0".
(2) If entry (2) is less than 20, change entry (2) to "20".
(4) If entry (4) is less than entry (5), entry (6) is "0".
(5) If entry (5) is less than 3, change entry (5) to "3".

METHOD OF PAYMENT

- ☐ Check enclosed as payment.
☐ Charge "TOTAL FEES DUE" to the Deposit Account No. below.
☒ No payment is enclosed.

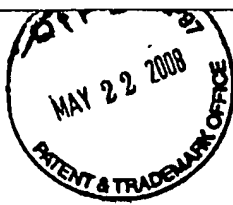
GENERAL AUTHORIZATION

- ☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to:
- Deposit Account No. 19-3935
Deposit Account Name STAAS & HALSEY LLP
- ☒ The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.

SUBMITTED BY: STAAS & HALSEY LLP

Typed Name	Sheetal S. Patel	Reg. No.	59,326
Signature	/Sheetal S. Patel/	Date	April 25, 2008

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Docket No.: 1614.1208

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kazutomi TANEDA, et al.

Serial No. 10/046,498

Group Art Unit: 3693

Confirmation No. 1961

Filed: January 16, 2002

Examiner: BARTLEY, KENNETH

For: ELECTRONIC COMMERCIAL TRANSACTION METHOD AND APPARATUS FOR
COMMUNICATING, VIA A NETWORK, VIRTUAL PERSONAL INFORMATION HAVING
A REPRESENTATION FORMAT SIMILAR TO THAT OF REAL PERSONAL
INFORMATION AND A CONVERTER CONVERTING THE VIRTUAL, INTO THE REAL,
PERSONAL INFORMATION BASED ON REGISTERED INFORMATION

AMENDMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action mailed January 25, 2008, and having a period for response set to expire on April 25, 2008.

The following amendments and remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.

IN THE CLAIMS:

The text of all pending claims (including withdrawn claims) is set forth below. Cancelled and not entered claims are indicated with claim number and status only. The claims as listed below show added text with underlining and deleted text with ~~strikethrough~~. The status of each claim is indicated with one of (original), (currently amended), (cancelled), (withdrawn), (new), (previously presented), or (not entered).

~~1.1.1.1~~ (CURRENTLY AMENDED) A communication method, comprising:

communicating to a manager, via a network, virtual personal information of a virtual world having a representation format similar to that of real personal information of a real world ~~to a manager within a virtual world~~; and

converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network; and
notifying the real personal information to an entity,

wherein the virtual personal information includes a virtual address in a virtual city within the virtual world.

~~2.2.2.2~~ (PREVIOUSLY PRESENTED) An electronic commercial transaction method, comprising:

making a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network,

wherein said virtual personal information having a representation format similar to that of real personal information of a real world, and includes a virtual address in a virtual city within the virtual world.

3. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 2, further comprising:

converting the virtual personal information into the real personal information in a managing apparatus provided in the network.

4. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 3, further comprising:

instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction, based on the real personal information.

5. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 2, further comprising:

seeking confirmation on an approval of the settlement to an individual in the real world who made the commercial transaction, based on the virtual personal information.

6. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 2, further comprising:

approving log-in to the virtual world; and

approving the commercial transaction in the virtual world.

7. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 6, wherein said approving the log-in and said approving the commercial transaction, respectively, approve based solely on the virtual personal information.

8. (PREVIOUSLY PRESENTED) The electronic commercial transaction method as claimed in claim 2, wherein said virtual personal information further includes at least one of a virtual name used in the virtual world, a virtual telephone number at the virtual address in the virtual city, a virtual bank account number of a virtual bank within the virtual city, and a virtual credit card number of a virtual credit card usable in the virtual world.

9. (CURRENTLY AMENDED) A managing apparatus, comprising:
managing means for managing registered information which is used when converting virtual personal information into real personal information of a virtual world of a real world, said virtual personal information having a representation format similar to that of the real personal information and including a virtual address in a virtual city within the virtual world; and
converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information; and
notifying means for notifying the real personal information to an entity.

10. (PREVIOUSLY PRESENTED) The managing apparatus as claimed in claim 9, further comprising:

means for instructing delivery and/or settlement of an item depending on a commercial transaction which is made in the virtual world in which the virtual personal information is used, based on the real personal information.

11. (PREVIOUSLY PRESENTED) The managing apparatus as claimed in claim 9, further comprising:

means for seeking confirmation on an approval of a settlement to an individual in the real world who made a commercial transaction in the virtual world in which the virtual personal information is used, based on the virtual personal information.

12. (CURRENTLY AMENDED) A system for managing a virtual city space within a virtual world, comprising:

a plurality of virtual shops accessible via a network,

a commercial transaction being made between a first virtual individual and an arbitrary one of the virtual shops, based on virtual personal information of the first virtual individual,

wherein said virtual personal information has a representation format similar to that of real personal information of a real world, and includes a virtual address in the virtual city space within the virtual world.

13. (CURRENTLY AMENDED) The virtual city spaces system as claimed in claim 12, further comprising:

a virtual home of a second virtual individual having a virtual address in the virtual city space, and

a communication being made between the first virtual individual and the second virtual individual, based on the virtual personal information of the first virtual individual.

14. (CURRENTLY AMENDED) The virtual city spaces system as claimed in claim 13, further comprising:

a virtual station through which the first virtual individual can move to another virtual city space.

REMARKS

In the Office Action mailed on August 9, 2007 the Examiner noted that claims 1-15 were pending, and rejected claims 1-16. Claim 1, 9 and 13-16 has been amended, no claims have been canceled, no claim has been added and, thus, in view of the forgoing claims 1-16 remain pending for reconsideration which is requested. No new matter is believed to have been added. The Examiner's rejections are respectfully traversed below.

Rejection under 35 U.S.C. § 101

The Office Action, on page 9, rejected claim 1 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claim provide no useful, concrete and tangible result. However, claim 1 has been amended to recite "notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101. Support can be found at page 12, lines 5-32 of the application.

The Office Action, on page 10, rejected claims 2-8 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 2 is so broad that it encompasses any type of commercial transaction thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument. It is submitted that the recitation of "making a *commercial transaction in a virtual world* on a network" in claim 2 has a practical application. Specifically, because the commercial transaction is "in a virtual world" setting taken place over a "network", real personal information of a user is protected. Therefore, one of ordinary skill in the art would clearly understand that claim 2 has a practical application. Thus, claim 2 and claims 3-8, which depend from claim 2, satisfy the requirements of 35 U.S.C. § 101.

The Office Action, on page 10, rejected claims 9-11 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claims provide no useful, concrete and tangible result. However, claim 9 has been amended to recite a "notifying means for notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101.

The Office Action, on page 10, rejected claims 12-15 under 35 U.S.C. § 101 because the claims were allegedly directed to non-statutory subject matter. However, claims 12-15 have been amended to recite "a system for managing a virtual city space within a virtual world" to overcome the rejection under 35 U.S.C. § 101.

The Office Action, on page 11, rejected claim 16 under 35 U.S.C. § 101 because the claim lacks patentable utility. Specifically, the Office Action asserted that claim 16 provides no

15. (CURRENTLY AMENDED) The ~~virtual city space~~system as claimed in claim 12, further comprising:

a virtual station through which the first virtual individual can move to another virtual city space.

16. ~~16.222~~ (CURRENTLY AMENDED) A method, comprising:

communicating, via a network, virtual information of a virtual user to at least one of a plurality of virtual entities within a virtual world, both the virtual user and the plurality of virtual entities representing a real person and real entities; ~~and~~

managing registered information of the virtual user and real user to convert virtual information into real information of a person; and

notifying the real personal information to an entity.

useful, concrete, and tangible result. However, claim 16 has been amended to recite "notifying the real personal information to an entity" to overcome the rejection.

Further, the Office Action rejected claim 16 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 16 is so broad that it would apply to everyone on the Internet thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument. It is submitted that at least one practical application of claim 16 is "managing registered information of the virtual user" and "managing registered information of the ... real user" to convert "virtual information into real information of a person". Moreover, the claim language is not so broad that it would apply to everyone, rather the language in claim 16 applies to "virtual users ... [and] virtual entities within the virtual world". Therefore, the language recited in claim 16 is not so broad as to have no practical application, as asserted by the Office Action.

Thus, in view of the foregoing, it is submitted that claims 1-16 satisfy the requirements of 35 U.S.C § 101. Accordingly, withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. § 112

The Office Action, on page 11, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement. Claim 1 has been amended to overcome the rejection. Support for the amendment can be found at Fig. 1 of the application.

The Office Action, on page 12, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 1 omits essential steps such as "creating virtual information from [the] registered information". According to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention". In this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claim. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "creating virtual information from [the] registered information" is an essential step. Claim 1 is directed to "communicat[e] to a manager ... virtual personal information ... and convert the virtual personal information into the real personal information based on registered information". Therefore, it is submitted that claim 1 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 12, rejected claims 1-16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. Particularly, the Office Action asserted that "virtual personal information" and "real personal information", as recited in claims 1, 2, 9, 12 and 16, could include anything. The assertion by the Office Action is traversed with an argument. Specifically, "virtual personal information" as recited in claim 1 is a "representation ... similar to that of real personal information". Stated another way, virtual personal information is information that represents the real information of the person (see Specification, page 8, line 13 to page 10, line 20). Therefore, one of ordinary skill in the art would clearly understand the meaning of "virtual personal information" and "real personal information" in light of the specification and would also clearly understand by simply reading the claim language recited in claims 1, 2, 9, 12 and 16. Thus, it is submitted that claims 1-16 satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 12, rejected claims 2-8 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 2 omits essential steps such as "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve real monetary transactions". However, as previously mentioned, according to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention". In this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claims. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve real monetary transactions" are essential steps. Claim 2 is directed to a commercial transaction method that allows a user to "mak[e] a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network". Accordingly, it is submitted that claim 2 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 13, rejected claim 16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. The Office Action asserted that there is no indication of how virtual information is communicated. However, claim 16, as amended, recites "communicating, via a network, virtual information of a virtual user to at least one of a plurality of virtual entities

within a virtual world". Therefore, claim 16, as amended, clearly points out how virtual information of a virtual user is communicated.

Further, the Office Action asserted that the recitation "managing registered information" in claim 16 is unclear. However, the Examiner's attention directed to the recitation "managing registered information of the virtual user and real user to convert virtual information into real information of a person" in claim 16. It is submitted that one of ordinary skill in the art would clearly understand when reading the above-quoted claim language that "registered information of the virtual user" and "registered information of ... [the] real user" is managed "to convert virtual information [of the virtual user] into real information of a [real] person". Therefore, claim 16 fully satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

Accordingly, withdrawal of the rejections is respectfully requested.

Rejection under 35 U.S.C. § 102

The Office Action, on page 13, rejected claim 1-16 under 35 U.S.C. § 102(e) as being anticipated by Shiloh (U.S. Publication No. 2001/0037316).

In the Response to Argument, on page 2 of the Office Action, the Examiner asserted that similar support can be found in Shiloh's provisional application. However, the Examiner has not indicated where such support can be found. The Examiner's attention is respectfully directed to the priority document filed with the Response on November 9, 2007, claiming priority over Shiloh. As such, Shiloh has been disqualified as prior art under 35 U.S.C. § 102 (e) because of the above-mentioned filed priority document. Therefore, it is submitted that the Examiner must issue a new non-final Office Action since the Applicant has claimed priority over Shiloh. Further, the Examiner is respectfully requested to indicate with specificity where in the provisional application of Shiloh the features of claims 1-16 are disclosed.

The Office Action, at item 15a on page 14, asserted that the bottom of paragraph 18 Shiloh discloses "a communication network that includes the Internet, intranets, and local networks". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15b on page 14, asserted that the middle of paragraph 20 of Shiloh discloses "a real entity represented by a virtual entity "... with an imaginary name, an

imaginary address, a virtual social security number, and any other data that may be required for the Internet activity of the virtual entity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15c on page 14, asserted that paragraphs 21 and 25 and 27 of Shiloh disclose "a computer system that manages both the real and virtual personal ... and provides a link between the virtual user and the real user". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15d on page 14, asserted that paragraph 22 of Shiloh discloses the "ability to conduct commercial transactions on the Internet using a virtual personality". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15e on page 14, asserted that the middle of paragraph 31 of Shiloh discloses "shipping items to a real address based on a virtual transaction by a virtual entity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15f on page 14, asserted that the middle of paragraph 26 of Shiloh discloses "the ability of a virtual person to authenticate (confirm) a transaction on the Internet using a fictional user name and information". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a

separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15g on page 14, asserted that paragraph 85 of Shiloh discloses "the user logs into a site by ... presenting the virtual user access ID and virtual user access password ... to gain access to their virtual identity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15h on page 14, asserted that paragraph 20 of Shiloh discloses "a virtual entity may obtain a virtual debit and credit card number". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15i on page 14, asserted that the middle of paragraph 31 of Shiloh discloses that "virtual users are able to make purchases of goods, presumably from virtual stores". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15j on page 15, asserted that the middle of paragraph 35 and paragraph 20 of Shiloh discloses that "users can have personalized virtual home pages that server as homes for entities and a ... virtual entity may enter a chat room and interact with other real and/or virtual entities". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15k on page 15, asserted that paragraph 21 of Shiloh discloses that "the system ... may be an organization operating a server site or series of server sites providing access to the Internet and/or other services ...". Further, the Office Action

asserted that paragraph 23 of Shiloh discloses that "while virtual stations and virtual city space are not discussed, Shiloh has the capability of offering it in that they provide virtual address information and provide management of the system and that entities can change personalities, which would include their virtual address". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15l on page 15, asserted that paragraph 21 of Shiloh discloses:

The system of the present invention is generally referred to herein as an Anonymous Virtual Personality Provider (AVPP). In an exemplary embodiment of the invention, an AVPP may include an organization and/or combination of computer hardware and/or software which provides services according to the system and method of the invention, such as an ISP, an Internet portal, financial services, shipping infrastructure, or any other system or organization that may be required in order to conduct business and/or to provide services on the Internet. For example, the AVPP may be an organization operating a server site or series of server sites providing access to the Internet and/or other services that may be required in order to implement and manage the virtual entities.

However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15m on pages 15 and 16, asserted that paragraph 33 of Shiloh discloses:

[P]ayments by a virtual personality over the Internet may be in the form of a virtual credit/debit cards registered to the virtual personality. This may be implemented using a real credit card number that may be issued to the AVPP by an existing credit card company. The AVPP may be directly responsible for the payment of its virtual users' credit card bills. For billing and credit card authentication purposes, each virtual credit card of an AVPP user may be registered with the address of the AVPP and the fictional identification information assigned to each user. Therefore AVPP manages ... converting virtual information into real world information.

However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully

requested to specifically point out where the alleged feature is disclosed in the provisional application.

Therefore, in view of the foregoing, the Examiner is respectfully requested to issue a new non-final Office Action because the Office Action, mailed January 25, 2008, improperly rejects claims 1-16 as failing to show where the features are allegedly disclosed in the provisional application of Shiloh.

Further, it is submitted that the provisional application of Shiloh fails to teach or suggest the features of claims 1-16 for the following reasons.

The provisional application of Shiloh is directed to a method and system that secures user identities and creates virtual users to enhance the privacy on a global computer network (see provisional application of Shiloh, page 1). Particularly, the provisional application of Shiloh describes a Virtuality System, which is a virtual personality provider, that is used to promote all Internet business and allow a user to use a virtual account to research and shop the Internet without disclosing the real identity of the user (see provisional application of Shiloh, page 1, paragraph 1 to paragraph 3). Stated another way, a user can conduct transaction with other Web sites using a virtual identity provided by Virtuality.

However, claim 1 is directed to a communication method that "communicat[es] to a manager, via a network, virtual personal information ... [that] includes a virtual address in a virtual city within a virtual world" so the manager can "convert the virtual personal information into the real personal information based on registered information". The provisional application is silent as to the above-quoted features in claim 1. Specifically, paragraphs 1-3 and Fig. 1 of the provisional application of Shiloh are silent as to how "the virtual personal information" is "[converted] into the real personal information" and is silent as to who does the "converting".

In claim 1, it is clear from the recitation that "converting ... [is] based on registered information" and that the manager does the converting. However, the provisional application of Shiloh is merely concerned with a proposed model for Virtuality having real world services with anonymous users and does not teach how information will be converted and by whom it will be converted. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted features of claim 1. Thus, it is submitted that claim 1 is patentable over the provisional application of Shiloh.

Further, claim 2 recites "making a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network".

However, Fig. 1 of the provisional application of Shiloh merely describes a user having Internet anonymity and describes a communication link between the user and the real world services, which are labeled under "Virtuality – Reality". One of ordinary skill in the art would clearly understand by viewing Fig. 1 in the provisional application of Shiloh that a user is using a virtual identity to communicate *in a real world environment* rather than a "transaction *in a virtual world*". Further, Fig. 1 clearly describes "real world services", "banking services", "privacy protection/promotion organization" but does not describe in any way that a "commercial transaction [is being made] in a virtual world" as in claim 2. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 2. Thus, it is submitted that claim 2 is patentable over the provisional application of Shiloh. Further, dependent claims 3-8 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 2, from which they depend.

With respect to claim 9, the last three lines on page 3 of the provisional application of Shiloh describes that linking between real identities and their corresponding virtual identities, for both debit and credit purposes, will be performed only within the internal accounting system of Virtuality, thereby fully protecting this crucial linking from being communicated to the Internet.

However, claim 9 recites "converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information". As previously mentioned, Shiloh fails to disclose as to how and what "convert[s] the virtual personal information received from the virtual city within the virtual world ... into corresponding real personal information of the real world". Rather, the last three lines on page 3 of the provisional application is merely concerned with who protects the information and does not teach how the information is converted and by what means the information is converted.

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 9. Thus, it is submitted that claim 9 is patentable over the provisional application of Shiloh. Further, the dependent claims 10 and 11 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 9, from which they depend.

With respect to claim 12, the last paragraph on page 12 of the provisional application of Shiloh describes that Virtuality users will be provided with a virtual spending account to make Internet shopping attractive to privacy-oriented users. Further, paragraph 1 on page 5 of the provisional application of Shiloh describes that Virtuality will allow users to make transactions

with websites such as Priceline.com while protecting the real identity of the user.

However, in claim 12 "a commercial transaction [is] made between a first virtual individual and an arbitrary one of the virtual shops". The above-quoted feature is not taught or suggested in the provisional application of Shiloh because the provisional application of Shiloh is merely concerned with allowing a real user to use a virtual identity to make transactions in the real world. Specifically, the provisional application of Shiloh describes a real user can use a virtual identity to make transaction on Priceline.com (e.g. real store), for example and is not concerned with a real user using a virtual identity to make a "commercial transaction ... [with] an arbitrary one of the virtual shops" as required in claim 12.

Further, the third and fourth paragraphs on page 5 of the provisional application of Shiloh describes a Virtuality Product Line that is directed to allow a user to purchase virtual personalities to allow a user to lead a full virtual life. Specifically, the personalities in the provisional application of Shiloh are not purchased from a virtual shop but rather purchased from Virtuality (e.g. a real entity). Therefore, neither paragraph teaches or suggests "[making] a commercial transaction ... between a first virtual individual and ... the virtual shops" because the cited paragraph are merely concerned with Virtuality selling personalities to a user, rather than describing a commercial transaction with "an arbitrary one of the virtual shops". Further, the entire reference is silent as to making any type of transaction with any *virtual shop*.

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-mentioned features recited in claim 12. Thus, it is submitted that claim 12 is patentable over the provisional application of Shiloh. Further, dependent claims 12-15 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 12, from which they depend.

In the Response to Arguments, on page 7 of the Office Action, the Examiner asserted that the Applicants specification indicates that a virtual shop in a virtual world can be indicated by a URL. Such an assertion by the Examiner is incorrect. The Examiner is respectfully requested to read page 9, line 36 to page 10, line 20 of the Specification in its entirety. The URL described in the Specification is an example of a way to describe a "virtual address", i.e. the location of the virtual shop within the virtual world". Such a "virtual address" recited in the independent claims 1, 2, 9 and 12 is not taught or suggested by the provisional application of Shiloh, but rather the provisional application of Shiloh is merely concerned making a transaction in the real world using a virtual identity. Therefore, based on this additional reason, the provisional application of Shiloh does not teach or suggest at least the above-mentioned feature recited in claims 1, 2, 9 and 12.

With respect to claim 16, the last paragraph on page 6 of the provisional application of

Shiloh describes that depending on the magnitude of business generated by Virtuality, and its growth Virtuality *may be able* to provide its users with any other existing Internet services. However, the cited paragraph does not teach or suggest how and by what means Virtuality will provide its user with *any* other existing Internet services. Such a blanket statement that that Virtuality may be able to provide does not teach or suggest how and by what means Virtuality will provide other existing Internet services. To that extent, the last paragraph on page 6 of the provisional application of Shiloh fails to teach or suggest how and by what means "virtual information of a virtual user" is communicated "to at least one of a plurality of entities *within a virtual world*" as recited in claim 16.

Therefore, it is submitted that claim 16 is patentable over the provisional application of Shiloh.

Accordingly, withdrawal of the rejection is respectfully requested.

Summary

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: April 25, 2008

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Attorney Docket No. 1614.1208

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kazutomi TANEDA, et al.

Application No.: 10/046,498

Group Art Unit: 3693

Confirmation No. 1961

Filed: January 16, 2002

Examiner: BARTLEY, KENNETH

For: ELECTRONIC COMMERCIAL TRANSACTION METHOD AND APPARATUS FOR COMMUNICATING, VIA A NETWORK, VIRTUAL PERSONAL INFORMATION HAVING A REPRESENTATION FORMAT SIMILAR TO THAT OF REAL PERSONAL INFORMATION AND A CONVERTER CONVERTING THE VIRTUAL, INTO THE REAL, PERSONAL INFORMATION BASED ON REGISTERED INFORMATION (As Amended)

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure provisions of 37 CFR § 1.56, there is hereby provided certain information which the Examiner may consider material to the examination of the subject U.S. patent application. It is requested that the Examiner make this information of record if it is deemed material to the examination of the subject application.

1. Enclosures accompanying this Information Disclosure Statement are:

- 1a. ☒ Form PTO-1449.
- 1b. ☒ Copy(ies) of IDS citation(s), except for U.S. Patents and U.S. Patent Application publications.
- 1c. ☐ English language copy of a communication(s) from a foreign Patent Office or a PCT International Search Report.
- 1d. ☒ English language translation (complete, Abstract or relevant portion(s)) attached to non-English language publications as indicated on the attached Form PTO-1449.
- 1e. ☐ Explanations of Relevancy of References (ATTACHMENT 1(e), hereto) for providing a concise explanation of non-English publications.
- 1f. ☐ List of Copending Applications (ATTACHMENT 1(f), hereto).
- 1g. ☐ List of Additional Submitted Documents (ATTACHMENT 1(g), hereto).

2. ☐ This Information Disclosure Statement is filed under 37 CFR § 1.97(b):

(Check either Item 2a or 2b or 2c or 2d)

- 2a. ☐ Within three months of the filing date of a national application;
- 2b. ☐ Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application.

- 2c. ☐ Before the mailing of a first Office Action on the merits; or
 2d. ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114.

3. ☒ This Information Disclosure Statement is filed under 37 CFR § 1.97(c) after the period specified in paragraph 2 above but before the mailing date of any of a Final Office Action under § 1.113, a Notice of Allowance under § 1.311 or an action that otherwise closes prosecution in the application, AND

(Check either Item 3a or 3b; Item 3b to be checked if any reference known for more than 3 months)

- 3a. ☐ The § 1.97(e) Statement in Item 5 below is applicable; OR
 3b. ☒ The \$180.00 fee set forth in 37 CFR § 1.17(p) is:
☐ enclosed.
☒ to be charged to Deposit Account No. 19-3935.

4. ☐ This Information Disclosure Statement is filed under 37 CFR § 1.97(d) after the period specified in paragraph 3 above, but on or before payment of the Issue Fee, AND

- 4a. ☐ The § 1.97(e) Statement in Item 5 below is applicable; AND
 4b. ☐ The \$180.00 fee set forth in 37 CFR § 1.17(p) is:
☐ enclosed.
☐ to be charged to Deposit Account No. 19-3935.

5. ☐ Statement under § 1.97(e) (applicable if Item 3a or Item 4a is checked)
(Check either Item 5a or 5b)

- 5a. ☐ In accordance with 37 CFR § 1.97(e)(1), it is stated that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
 5b. ☐ In accordance with 37 CFR § 1.97(e)(2), it is stated that no item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known by any individual designated in § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

6. ☐ This is a continuation/divisional/continuation-in-part application under 37 CFR § 1.53(b).

(Check appropriate Items 6a and/or 6b)

- 6a. ☐ Copies of the publications listed on the attached Form PTO-1449 which were previously cited in prior application Serial No. __, filed on __, and which is relied on for an earlier effective filing date for the subject application under 35 U.S.C. § 120, have been omitted pursuant to 37 CFR § 1.98(d).


- 6b. ☐ Copies of the publications listed on the attached Form PTO-1449 which were not previously cited in prior application Serial No. ___, filed on ___, and which is relied on for an earlier effective filing date for the subject application under 35 U.S.C. § 120, are provided herewith.
7. ☐ This is a Request for Continued Examination under 37 CFR § 1.114.
(Check either Item 7a or 7b)
- 7a. ☐ The Issue Fee has not been paid.
- 7b. ☐ A Petition to Withdraw from issue under 37 CFR § 1.313(c) is filed concurrently herewith or has been granted. A Request for Continued Examination under 37 CFR § 1.114, after payment of the Issue Fee, is proper in accordance with 37 CFR § 1.114(a), respectively.
8. ☐ This is a Supplemental Information Disclosure Statement.
(Check either Item 8a or 8b)
- 8a. ☐ This Supplemental Information Disclosure Statement under 37 CFR § 1.97(f) supplements the Information Disclosure Statement filed on ___. A bona fide attempt was made to comply with 37 CFR § 1.98, but inadvertent omissions were made. These omissions have been corrected herein. Accordingly, additional time is requested so that this Supplemental IDS can be considered as if properly filed on ___.
- 8b. ☐ This Supplemental Information Disclosure Statement is timely filed within one (1) month of the Notice under 37 CFR §§ 1.97 and 1.98, mailed ___.
9. ☐ In accordance with 37 CFR § 1.98, a concise explanation of what is presently understood to be the relevance of each non-English language publication is:
(Check appropriate Items 9a, 9b, 9c and/or 9d)
- 9a. ☐ satisfied for the non-English language publication(s) cited on the enclosed "English language version of the search report or action which indicates the degree of relevance found by the foreign office". (See MPEP § 609, Minimum Requirements for an Information Disclosure Statement, Part A(3): Concise Explanation of Relevance, 8th Ed., Rev. 2)
- 9b. ☐ set forth in the application.
- 9c. ☐ satisfied for the non-English language publication(s) indicated on the attached Form PTO-1449 as having an English language translation (complete or relevant portion(s)) attached thereto.
- 9d. ☐ enclosed as Attachment 1(e), hereto.
10. No admission is made that the information cited in this Statement is, or is considered to be, material to patentability nor a representation that a search has been made (other than search report(s) from a counterpart foreign application or a PCT International Search Report, if submitted herewith). 37 CFR §§ 1.97(g) and (h).

11. The Commissioner is authorized to credit any overpayment or charge any additional fee required under 37 CFR § 1.17 for this Information Disclosure Statement to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Dated: April 25, 2008
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FORM PTO-1449

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO.

1614.1208

Sheet 1 of 1

APPLICATION NO.

10/046,498

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

FIRST NAMED INVENTOR

Kazutomi TANEDA, et al.

FILING DATE

January 16, 2002

GROUP/ART UNIT

3693

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	TRANSLATION YES NO		ABSTRACT
	AG	10-162067	6/19/1998	JAPAN	X		YES
	AH	2000-076336	3/14/2000	JAPAN	X		YES
	AI						
	AJ						
	AK						
	AL						

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

TRANSLATION
YES NO

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EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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